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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/700,207

11/03/2003

David B. Skursha

3206

4179

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7590

02/24/2009

THE LUBRIZOL CORPORATION  
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EXAMINER

NGHIEM, MICHAEL P

ART UNIT

PAPER NUMBER

2863

MAIL DATE

DELIVERY MODE

02/24/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/700,207	<b>Applicant(s)</b> SKURSHA ET AL.	
	<b>Examiner</b> MICHAEL P. NGHIEM	<b>Art Unit</b> 2863	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 5-29-08, 6-10-05, 3-7-05.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,5 and 12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5 and 12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

The Communications filed on May 29, 2008, June 10, 2005, and March 7, 2005 have been considered.

#### ***Petition***

The petition under 37 C.F.R. 1.181 is GRANTED and thereby, the petition to revive under 37 C.F.R. 1.137(b) is DISMISSED as moot.

#### ***Terminal Disclaimer***

The terminal disclaimer filed on March 7, 2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patent Application 10/271,885 has been reviewed and is accepted. The terminal disclaimer has been recorded.

#### ***Specification***

The substitute specification filed on May 28, 2008 has not been entered because it does not conform to 37 CFR 1.125(b) and (c) because:

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- it is not accompanied by a statement that the substitute specification includes no new matter.
- an accompanying clean version (without markings) has not been supplied.

The disclosure is objected to because of the following informalities: The specification is required to be corrected to reflect the cancelled drawings: Figs. 5-15.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12, "...a property of the determined data-temperature-dependence not being within at least one property" is not understood.

### ***Claim Rejections - 35 USC § 101***

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35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 5, and 12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The method is not tied to another statutory class (such as a particular apparatus) or transforms an underlying subject matter (such as an article or material). Thus, the method is not a patent eligible process under 35 USC 101 and is directed to non-statutory subject matter. See *In re Bilski*, Appeal No. 2007-1130.

To qualify as a 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Lvovich et al. (US 2002/0125899).

Regarding claim 1, Lvovich et al. discloses a method to temperature compensate data of a fluid while in use (paragraph 0015) that comprises:

a) collecting data (electromechanical impedance, paragraph 0088, lines 1-3) when fluid temperature changes from a first threshold (T1 level) temperature to at least a second threshold temperature (T2 level) at least at a threshold rate (monitoring electromechanical impedance as a function of fluid's temperature, temperature changes from T1 to T2 inherently at a rate, Fig. 9);

b) determining the temperature dependence of the collected data (electromechanical impedance varies as a function of fluid's temperature, paragraph 0088, lines 1-3); and,

c) using the determined data-temperature-dependence for temperature compensating data of the fluid's condition (paragraphs 0015, 0029).

Regarding claim 5, Lvovich et al. discloses determining at least one of the following selected from the group consisting of threshold temperature (T1 or t2 temperature

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levels).

Regarding claim 12, Lvovich et al. discloses a property of the determined data temperature-dependence not being within at least one property is selected from the group consisting of: the determined data-temperature-dependence alone (electromechanical impedance depends on fluid's temperature, paragraph 0088, lines 1-3); a function of the determined data-temperature-dependence (electromechanical impedance varies as a function of fluid's temperature, paragraph 0088, lines 1-3) and the current data-temperature-dependence (electromechanical impedance depends on fluid's temperature, paragraph 0088, lines 1-3) and combinations thereof (electromechanical impedance depends on and varies as a function of fluid's temperature, paragraph 0088, lines 1-3).

### ***Response to Arguments***

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

### ***Contact Information***

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael P Nghiem whose telephone number is (571) 272-2277. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached at (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Michael P. Nghiem/

Primary Examiner, GAU 2863

February 18, 2009